

REMARKS

Claims 7-14 and 17 were previously pending in this application. Claims 1-6, 15 and 16 have been canceled without prejudice or disclaimer. Applicants thank the Examiner for withdrawal of the rejections based on Gordon, U.S. Patent No. 4,101,701, and Keng, U.S. Patent No. 5,362,540, asserted in the June 27, 2005 Office Action. Applicants respectfully request reconsideration of the Application in view of the following remarks.

Interview Summary

Applicants wish to thank the Examiner for the courtesy extended to Applicants' representative on February 28, 2006, when the representative called the Examiner to discuss the January 3, 2006 Office Action. During the telephone conversation, Applicants' representative discussed the Examiner's analogy of the elements in Castle et al., U.S. Patent No. 6,185,812 B1, to each element in the Application. Specifically, the representative noted that the Examiner's rejection under 35 U.S.C. § 102(b) analogized element 21 in Fig. 2 of Castle et al. to both the resin film 5 and the resin panel body 2 in the Application. *See* Office Action, 1/3/06, p. 3. The Examiner stated that this was a typographical error and that the resin film 5 in the Application is analogous to element 20 in Figure 2 of Castle et al.

Moreover, Applicants' representative explained that independent claim 7 in the Application recites a second binder layer 7 that directly contacts the printed part 4 along a surface of the printed part 4 that faces the resin panel body 2. The representative then indicated to the Examiner that what the January 3, 2006 Office Action refers to in Castle et al. as the "second binder layer," i.e., glass inner ply 22, does not contact the printed part 4 in the

Application along a surface of the printed part 4 that faces what the January 3, 2006 Office Action refers to in Castle et al. as the resin panel body 2, i.e., glass outer ply 21. *See* Office Action, 1/3/06, p. 3. The Examiner conceded that this aspect of Applicants' invention was not disclosed by Castle et al. Specifically, the Examiner indicated that she had misread the language disclosed in claim 7 of the Application and did not recognize the import of Applicants' "along a surface of the printed part" limitation. In light of this argument, the Examiner stated that she currently had no other basis for rejection of the instant application.

Accordingly, the Examiner indicated to Applicants' representative that Applicants need not amend the claims in response to the January 3, 2006 Office Action. Instead, the Examiner advised Applicants' representative to simply submit a Response disclosing the above argument relating to "along a surface of the printed part" and the Application would be considered from there.

Claim Rejections – 35 U.S.C. § 102

Claims 7-11, 13-14 and 17 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Castle et al., U.S. Patent No. 6,185,812 B1. Applicants respectfully submit that the pending claims are patentably distinct from the cited reference.

Independent claim 7 recites, *inter alia*:

A resin panel comprising: a resin panel body; and a film for insert molding used fixed in an injection molding mold arranged on a surface of said resin panel body, said film comprising: a resin film; a first binder layer formed on the surface of the resin film; a printed part formed on the first binder layer; and a second binder layer formed to seal said

printed part in co-operation with the first binder layer, wherein the second binder layer directly contacts both the printed part, along a surface of the printed part which faces said resin panel body, and the first binder layer, along a periphery of the printed part, wherein the first binder layer, printed part and second binder layer are formed in this order

Applicants submit that Castle et al. cannot anticipate independent claim 7 because it does not teach every element of this claim. *See* MPEP § 2131. Castle et al. disclose a method for making an electrically heated window comprised of at least two plies of glass (21, 22), at least one ply of interlayer material (23) and an electrically resistant heating area means, *e.g.*, a busbar (6). Castle et al. are particularly concerned with obscuring the busbar (6) from external view by positioning the busbar (6) along the edge of the window and covering it with an obscuration band (20). Castle et al. are silent, however, as to “a second binder layer formed to seal said printed part in co-operation with the first binder layer, wherein the second binder layer directly contacts both the printed part, along a surface of the printed part which faces said resin panel body.” As conceded by the Examiner in the February 28, 2006 Interview, Castle et al. do not disclose this element of the Applicants’ invention.

In view of the above remarks and pursuant to the Examiner’s instructions, Applicants respectfully submit that Castle et al. do not teach or suggest every element recited independent claim 7 or claims 8-11, 13-14 and 17 depending therefrom. Accordingly, these claims define patentable subject matter over Castle et al. Applicants respectfully request withdrawal of this ground of rejection.

Claim Rejections – 35 U.S.C. § 103

Claim 12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Castle et al. Applicants respectfully submit that the pending claims are patentably distinct from the cited reference.

To establish a *prima facie* case of obviousness, a prior art reference must teach or suggest all the limitations of a claim. *See* MPEP § 706.02(j). The January 3, 2006 Office Action indicates that Castle et al. disclose “the resin panel described above” and states that although Castle et al. are silent as to a resin body and resin film made from polycarbonate, it would have been obvious to one having ordinary skill in the art to provide Castle et al. with a polycarbonate resin body and resin film. *See* Office Action, 1/3/06, p. 5. However, as noted above, Castle et al. do not disclose a “resin panel [as] described above” because Castle et al. admittedly cannot anticipate Applicants’ independent claim 7. Moreover, nothing further in Castle et al. teaches or suggests every element of dependent claim 12. Therefore, because Castle et al. does not teach or suggest every element of claim 12, such claim cannot be rendered *prima facie* obvious in view of Castle et al.

For at least the above reason, Applicants submit that dependent claim 12 is patentably distinct from the cited reference. Accordingly, Applicants request withdrawal of this ground of rejection.

Serial No. 09/626,811
Response dated March 28, 2006
Reply to Office Action of January 3, 2006

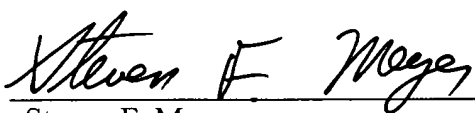
Docket No. 5000-4777

CONCLUSION

Based on the following remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

Respectfully submitted,
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